

REMARKS

Upon entry of the instant Amendment, claims 1-17 and 21-23 will be pending in the application. Claims 1, 12 and 21 are independent. By this amendment, the drawings, the specification and claims 1, 5, 10-12, 14 and 17 will have been amended and claims 21-23 have been added. Support for the amendment to Fig. 2 can be found on page 7, lines 9-11 of the specification. Support for the amendment to claims 1 and 12 and new claims 21-23 is provided on at least page 6, lines 26-28 of the specification. No new matter is added. Reconsideration of the objections and rejections in view of the above amendments and the following remarks is respectfully requested.

Drawing Objection

The drawings were objected to under 37 CFR 1.83(a) because the second binding member is allegedly are not shown.

Applicants respectfully disagree. The Examiner is requested to closely examine amended Fig. 2 which shows the second binding member 112. Applicants are submitting herewith a Replacement Sheet drawing sheet amending Fig. 2 which illustrates the second binding member. No new matter has been added.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the objection to the drawings.

Objection to the Specification

The specification was objected to because page 6, line 27 includes a typographical error and because page 7, line 9 refers to reference number 112 as the second binding member.

Applicants submit that the former basis of objection has been rendered moot by the instant amendment to the specification.

With regard to the latter basis, Applicants respectfully disagree that the second binding member is not properly labeled as reference number 112. As the Examiner will note, each location in the specification referencing number 112 consistently describes this feature as the second binding member.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the objection to the specification.

35 U.S.C. § 112, second paragraph, Rejection

Claims 5, 12, 14 and 17 (claim 16 was incorrectly listed instead of claim 17) were rejected under 35 U.S.C. § 112, second paragraph, for being allegedly indefinite.

By this Amendment, Applicants submit that this basis of rejection has been rendered moot. Applicants note, in particular, that claims 5, 12, 14 and 17 have been amended consistent with the Examiner's assertion of indefiniteness, i.e., the claims have been amended in a manner wherein the product is not positively recited.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims.

35 U.S.C. § 102 Rejection

Claims 1, 2, 4, 5, 12, 14 and 16 were rejected under 35 U.S.C. § 102(b) for being allegedly anticipated by U.S. Patent No. 1,286,374 to McDONALD.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation cannot be established because McDONALD fails to teach each and every element of the claims as amended.

More particularly, amended independent claims 1 and 12 each recites, *inter alia*, a portion of one of the first and second constraining walls being folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system.

Applicants submit that McDONALD does not disclose or even suggest at least this feature. Applicants acknowledge, for example, that McDONALD teaches a mail tray which has a first constraining wall A and a second constraining wall B and a first binding member E (see Fig. 1). Applicants respectfully submits that, in contrast to the instant invention, the wall C of McDONALD is not disclosed as being a portion of one of the first and second constraining walls that is folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system. Applicants note that McDONALD merely describes wall C as an end wall.

Applicants also submit that the disclosed mail tray is unlike the instant invention in at least one important aspect. The invention provides that "the product can be unbound and set on an automatic feeder at a postal delivery facility without any further processing. In this manner, manual operations need not be performed on the stacks prior to mail sorting." McDONALD, on the other hand, discloses a tray that is specifically designed for manual use. That is, the user places the mail pieces of the tray, adjusts the plate D as necessary and tightens and loosens the strap E to remove and insert mail pieces. Such a device is clearly not designed or adapted for an automatic feeder.

Accordingly, Applicants respectfully submit that independent claims 1 and 12 as well as dependent claims 2, 4, 5, 14 and 16, which depends from claims 1 and 12 are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) should be withdrawn.

35 U.S.C. § 103 Rejection

Claims 3 and 13 were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over McDONALD in view of U.S. Design Patent No. 415,730 to JACOBSMEYER.

The Examiner acknowledges that McDONALD lacks, among other things, the recited second binding member. However, the Examiner explains that this feature is taught by JACOBSMEYER and that it would have been obvious to combine the

teachings of these documents. Applicants respectfully submit that a *prima facie* case of obviousness has not been established as the applied references fail to teach each and every element of the claims.

Applicants submit that neither McDONALD nor JACOBSMEYER disclose or suggest the combination of features recited in at least independent claims 1 and 12, from which claims 3 and 13 depend. Applicants also submit that no proper combination of these documents disclose or suggest the combination of features recited in at least claims 1 and 12.

As explained above, the wall C of McDONALD is not disclosed as being a portion of one of the first and second constraining walls that is folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system. To the contrary, McDONALD merely describes wall C as an end wall.

Additionally, while the Examiner has identified the perpendicularly arranged binding members in Figs. 9 and 10 of JACOBSMEYER, it is clear that the design shown in JACOBSMEYER lacks any end caps, much less, that a portion of one of the first and second constraining walls that is folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system.

Moreover, in addition to failing to disclose the combination of features recited in the above-noted claims 1 and 12, Applicants submit no proper combination of these

documents discloses or suggests the combination of features recited in claims 1 and 12 or in the above-noted claims 3 and 13 which depend from claims 1 and 12.

Accordingly, Applicants respectfully submit that the above-noted rejection under 35 U.S.C. § 103(a) should be withdrawn.

New Claims are also Allowable

Applicants submit that the new claims 21-23 are allowable over the applied art of record. Specifically, claims 21-22 recite a combination of features which are clearly not disclosed or suggested by the applied art of record. Specifically, Applicants submit that the applied documents fail to disclose or suggest, for example, the end caps arranged on the upper extending constraining wall and first binding member in combination with the other recited features. Applicants note, in particular, that neither McDONALD nor JACOBSMEYER (nor any proper combination thereof) teaches, for example, the end caps arranged on the upper extending constraining wall and first binding member in combination with the other recited features. Applicants note that McDONALD merely teaches to use a fixed side wall C and a movable side wall D. Additionally, JACOBSMEYER merely teaches to use open side walls without any caps. Moreover, new claim 23 depends from claim 1 which is believed to be allowable over the art of record. Accordingly, Applicant respectfully requests consideration of these claims and further request that the above-noted claims be indicated as being allowable.

Request for Rejoinder of Non-Elected Claims

Applicants further submit that rejoinder of withdrawn claims 6-11, 15 and 17 is now proper, because these claims depend from claims 1 and 12 which are believed to be allowable.

Applicants refer the Examiner to MPEP 821.04 which indicates that withdrawn claims which depend from or otherwise include all the limitations of the allowable claims will be rejoined if presented prior to allowance and issuance of a final rejection.

Accordingly, Applicants request that the Examiner rejoin these claims directed to the non-elected invention and consider the merits of the same.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Respectfully submitted,
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AMENDMENT TO THE DRAWINGS

Please replace the drawing sheet showing Figs. 2, 4 and 5 with the attached Replacement Sheet drawing sheet showing Figs. 2, 4 and 5.

Fig. 2 has been amended as follows:

The member designated reference number 112 has been added and the lead line for reference number 112 has been moved to extend to the added member.

Applicant submits that no new matter has been added.